APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/309,831	05/11/1999	THOMAS C. MIELENHAUSEN	90021-3	8013

32300	7590	01/27/2005

BRIGGS AND MORGAN, P.A.
2200 IDS CENTER
MINNEAPOLIS, MN 55402

EXAMINER
HUYNH, CONG LAC T

ART UNIT	PAPER NUMBER
2178	

DATE MAILED: 01/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	**Applicant(s)**
Office Action Summary	09/309,831	MIELENHAUSEN, THOMAS C.
	Examiner	**Art Unit**	
	Cong-Lac Huynh	2178	

-- The MAILING DATE f this communication appears on the c ver sheet with the correspondenc address --

Period f r Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>30 July 2004</u>.

2a)☒ This action is **FINAL.** 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle,* 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-22* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-22* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Pri rity under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)   4)☐ Interview Summary (PTO-413)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)   Paper No(s)/Mail Date. _____ .
3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)   5)☐ Notice of Informal Patent Application (PTO-152)
    Paper No(s)/Mail Date _____ .   6)☐ Other: _____ .

DETAILED ACTION

1.   This action is responsive to communications: response filed 7/30/04 to the

application filed on 5/11/99.

2.   Claims 1-22 are pending in the case. Claims 1, 15, 17 are independent claims.

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

4.   Claims 1-22 remain rejected under 35 U.S.C. 103(a) as being unpatentable over

Ichbiah (US Pat No. 5,623,406, 4/22/97, filed 3/6/95) in view of Goldwasser (US Pat No.

5,096,423, 3/17/92, filed 12/29/87).

Regarding independent claim 1 and its dependent 9-10, Ichbiah discloses:

- storing in the memory a second data structure encoding a plurality of

    abbreviations and corresponding words (col 4, lines 53-67: a glossary of

    abbreviations and the corresponding words and phrases is stored in the system;

    col 5, line 25 to col 6, line 18; abstract: "retrieving words and phrases from

    abbreviations" inherently shows there is a list of abbreviations and corresponding

    words and phrases for retrieving)

- displaying a list of suggested words and phrase corresponding to the selected

abbreviation, and receiving input from the user to choose the desired word and

phrase for the abbreviation (col 4, lines 53-67: the fact that multiple matching

words and phrases for a proposed abbreviation are displayed by the system in

the form of option in advisory table upon the entry of characters into the system

shows displaying a list of suggested words and phrases for an abbreviation for

selecting; col 12, lines 42-67: more than one choice of matching words are

displayed to users for selecting)

Ichbiah does not explicitly disclose:

- storing in the memory a first data encoding a plurality of words and

  corresponding abbreviations

- selecting a word in the text to be converted to an abbreviation and converting the

  selected word to a corresponding abbreviation

- selecting an abbreviation in the text to be converted to a word and converting the

  abbreviation to a word

Instead, Ichbiah discloses that:

- a glossary of abbreviations and corresponding words and phrases (col 5, line 25

  to col 6, line 38) which is considered equivalent to the second data structure

- entering of data in the form of abbreviation and standard text entry (col 5, lines

  16-18)

- converting the abbreviation to the corresponding phrase (col 6, lines 10-60)

This inherently shows that the entered data in the form of abbreviation is selected to be

converted to corresponding phrase using the data in the glossary. In other words,

Ichbiah discloses selecting an abbreviation in the text to be converted to a word and

converting the abbreviation to a word using the second data structure.

Goldwasser discloses:

- storing a data structure encoding a plurality of words and corresponding

    abbreviations (col 5, lines 27-33: storing the sequences of keypresses, which are

    long sequences of characters of words, and the correspondent abbreviations)

- selecting a word in the text to be converted to an abbreviation and converting the

    selected word to a corresponding abbreviation using said data structure

    (abstract; col 2, lines 39-64; col 4, line 28 to col 5, line 11: recognizing the

    sequence of keypresses typed of a word that has a corresponding abbreviation

    and converting the keypresses into a corresponding abbreviation according to

    the stored list of words and corresponding abbreviation; said recognizing

    inherently indicates that said word in the entered text is selected for converting to

    abbreviation based the stored list in memory)

It would have been obvious to one of ordinary skill in the art at the time of the invention

was made to have combined Goldwasser into Ichbiah to obtain converting from a word

and phrase to a corresponding abbreviation and converting from an abbreviation to a

corresponding word and phrase since Goldwasser provides the first method and Ichbiah

provides the second method where both are to help users fast finding a right word or a

right abbreviation in writing documents.

Regarding claims 2 and 16, Ichbiah discloses editing, updating and customizing the

data structures, which are words and corresponding abbreviations (col 7, line 55 to col 8, line 47; col 14, lines 3-27; col 11, line 35 to col 12, line 40). Lu also discloses these features (col 3, lines 17-36; col 5, lines 20-68).

Regarding claims 3-6, Ichbiah discloses that the word or an abbreviation is selected by a user using a keyboard command or using a mouse (col 3, lines 63-65; col 6, line 53 to col 7, line 3; col 12, line 60 to col 13, line 5; col 14, lines 29-58).

Regarding claims 7-8, 11-12, Ichbiah discloses:

- displaying a list of suggested abbreviations corresponding to the selected word and receiving input from the user to choose the desired abbreviation (col 5, lines 15-60)

- recognizing an abbreviation to be converted to words and phrases when entering text data (col 5, lines 16-24; col 6, line 33 to col 7, line 3; col 14, line 29 to col 15, line 55)

- receiving input from the user to choose the desired abbreviation corresponding to the phrase or to choose the desired phrase corresponding to the abbreviation (col 12, line 42 to col 13, line 20)

- converting the abbreviations to corresponding words or phrases (col 12, line 42 to col 13, line 20: the input command from the user is for converting an abbreviation to a corresponding word and phrase)

Ichbiah does not explicitly disclose:

- displaying a list of suggested words and phrases corresponding to an abbreviation

- scanning the text for words to be converted to abbreviations and converting words selected by the data processing to corresponding abbreviation

- scanning the text for abbreviations to be converted to words or phrases and

Goldwasser discloses a list of suggested words and phrases corresponding to an abbreviation (col 3, lines 8-37: providing a menu of linguistic expressions of words and phrases having corresponding abbreviation for users to select one).

It would have been obvious to an ordinary skill at the time of the invention was made to have modified Ichbiah and Goldwasser to include scanning text for abbreviations to be converted to corresponding words and scanning text for words and phrases to be converted to corresponding abbreviations for the following reason.   The fact that the entry of data text is *recognized* for a corresponding abbreviation based on the glossary of words and abbreviations suggests scanning the entered text for a corresponding abbreviation.

Regarding claims 13-14, Ichbiah discloses selecting an abbreviation from the first data structure (abstract; col 3, lines 50-65), and selecting an abbreviation from the second data structure (col 4, line 53 to col 5, line 60). Ichbiah also discloses that when typing the abbreviation, the corresponding phrase is inserted in the displayed text (figure 3; col 14, line 28 to col 15, line 27).   This shows that a phrase or word corresponding to a selected abbreviation is inserted into the text at a position selected by the user.

Independent claim 15 includes the same limitations as in claims 1, 9-10, and 13-14, and is rejected under the same rationale.

Independent claim 17 and its dependent claim 22 are for a data processing apparatus for performing the method claims 1, 9-10, and 13, and are rejected under the same rationale.

Claims 18-22 are for a data processing apparatus of method claims 7-8, 11-12, and are rejected under the same rationale.

Response to Arguments

5.   Applicant's arguments filed 7/30/04 have been fully considered but they are not persuasive.

Regarding claim 1, Applicants argue that Goldwasser does not teach selecting a word in the text to be converted to an abbreviation since in Goldwasser, the user is merely making data entry to existing text, not selecting a word in the existing text to be converted (Remarks, page 3).

Examiner respectfully disagrees.

Goldwasser does disclose selecting a word in the text to be converted to an abbreviation (abstract: a teaching method is disclosed for computer systems that permit longer sequences or user actions such as keypresses or *selection* via pointing *to be replaced by shorter sequences of user actions (abbreviations)"*; col 2, line 56 to col 3,

line 27:".. the number of letters of a word or phrase that must be typed before the word

or phrase will be displayed in the menu, and the position of the word or phrase in the

menu, so that the *user can add this word or phrase to the text* by typing this number of

letters and *then selecting the word or phrase from the menu...the character of the*

longer sequence of text words which are part of the corresponding abbreviation or

designate the appropriate menu can be highlighted..."; the fact that the user *can add*

this word/phrase to the text and the text in the menu that has corresponding

abbreviation *is highlighted* clearly shows selecting, by a user, a word in the text to be

converted to an abbreviation).

Regarding claims 3-6, Applicants argue that Ichbiah only converts abbreviations to

words, not vice-versa, and therefore, does not teach converting words to abbreviations.

Examiner agrees.

However, Goldwasser, in combination with Ichbiah, discloses converting words to

abbreviations as in the claim rejections.

Regarding claim 7, Applicants argue that the reference do not disclose the step of

scanning the text for words to be converted to abbreviations and converting words

selected by the data processing method to corresponding abbreviations using the first

data structure (Remarks, page 4).

Examiner respectfully disagrees.

The fact that Ichbiah discloses recognizing an abbreviation to be converted to words

and phrases when entering text data (col 5, lines 16-24; col 6, line 33 to col 7, line 3; col

14, line 29 to col 15, line 55) suggests that the text data is scanned for recognizing an

abbreviation to be converted to words and phrases.

Regarding claim 13, Applicants argue that Examiner's statements are self-contradictory

since Examiner states "Ichbiah does not explicitly disclose storing in memory a first data

[structure] encoding a plurality of words and corresponding abbreviations" then states

that "Ichbiah discloses selecting an abbreviation from the first data structure" (Remarks,

page 4).

Examiner respectfully disagrees.

Ichbiah does not disclose storing the first data structure of a plurality of words and

abbreviations but instead discloses storing the second data structure of a plurality of

abbreviations and corresponding words (office action, pages 3).

Goldwasser, in combination with Ichbiah, discloses storing a data structure of a plurality

of words and corresponding abbreviations (office action, page 4) where said data

structure is considered equivalent to the first data structure.   The fact that the

abbreviation in the abbreviation list is recognized to be the corresponding abbreviation

of the keypresses typed of a word implies a selecting of said abbreviation as a proper

one among the other abbreviations in the list.

Regarding claim 15, Applicants argue that the reference do not show the step that "the user instructing the data processing method to select a position in the text for insertion of an abbreviation" (Remarks, page 4).

Examiner respectfully disagrees.

Goldwasser discloses "the user instructing the data processing method to select a position in the text for insertion of an abbreviation" (col 2, lines 44-49, line 56 to col 3, line 27:"teaching a computer system user *shorter sequences of user actions (abbreviations)* for causing the computer to perform data manipulations of all types, including text and data processing functions, corresponding to longer sequences of user actions", ".. both the number of letters of a word or phrase that must be typed before the word or phrase will be displayed in a menu ... and the position of the word or phrase in the menu, so that the *user can add this word or phrase to the text* by typing this number of letters and then selecting the word or phrase from the menu... characters of the longer sequence of text words which are part of the corresponding abbreviation or *designate the appropriate menu can be highlighted..* the keys which correspond to the characters of the abbreviation, or the characters which designate the menu, can be blinked... "; the fact that the user *can add this word/phrase to the text* and the text in the menu that has corresponding abbreviation is highlighted clearly shows selecting, by a user, a position in the text for inserting an abbreviation).

Conclusion

6.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the mailing date of this final action.

7.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

Howell et al. (US Pat No. 4,459,049, 7/10/84).

Kudrolli et al. (US Pat No. 6,279,018 B1, 8/21/01, filed 2/23/99).

Anonymous, A Shortcut for Inserting Preformatted Text, Inside Corel WordPerfect Suite,

Jan 1998, vol. 3, page 19, 2 pgs.

8.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Cong-Lac Huynh whose telephone number is 571-272-

4125. The examiner can normally be reached on Mon-Fri (8:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Stephen Hong can be reached on 571-272-4124. The fax phone number for

the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

Clh
1/10/05

CESAR   B   PAULA
PRIMARY EXAMINER
AU   2178